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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,735	02/06/2001	Edward E. Williams	GOEA 1803001	8711
32233	7590	09/08/2004		
STORM & HEMINGWAY, L.L.P. 8117 PRESTON RD. STE. 460 DALLAS, TX 75225				
EXAMINER FLORES SANCHEZ, OMAR				
ART UNIT		PAPER NUMBER		
3724		<i>12</i>		

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,735

Applicant(s)

WILLIAMS, EDWARD E.

Examiner

Omar Flores-Sánchez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-8,10,12,14-16 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-8,10,12,14-16 and 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 6/26/04.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter is "the second material are sharpened before inserting them into each channel". In the specification, page 4, lines 22-24, applicant said that "after the cutting blade is secured into the cutting blade holder, the cutter may be sharpened", which is evidence that the above subject matter was not described.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-2, 5-10,13-16, 41-43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Osenbruggen.

Van Osenbruggen discloses the method for manufacturing a rotatable cutting blade including: selecting a substantially circular cutting blade holder made of a first material (col.4, line 61-63, steel which is made of carbon) having two spaced apart faces (spaced by the width of the blade holder) and having a plurality of cutting blade channels (Fig. 1) forming an angle with respect to a plane defined by the faces, inserting a piece of a second material (Fig. 3 and col. 8, line 64-66), the piece of second material having sufficient height to extend at least one edge of the cutting blade beyond the plane defined by at least one face one face (Fig. 10), bonding each said piece of second material (col. 9, line 53-54), sharpening said pieces (col. 5, lines 3-6 and col. 9, lines 40-42), brazing with a solder along substantially the entire length of said cutter blade channel (col. 9, line 38-39) and at least a portion of at least one edge 1020 of the cutting blade is sharpened such that the sharpened edge is parallel to the plane defined by the face (Fig. 10).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Osenbruggen as applied to claims 1 and 9 above, and further in view of Kubis.

Van Osenbruggen discloses the method for manufacturing a rotatable cutting blade substantially as claimed except for molding process. However, Kubis teaches the use of a molding process (see col. 4, line 11-13 and 15-17) for the purpose of obtaining a high level of dimensional accuracy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Van Osenbruggen's device by providing the molding process as taught by Kubis in order to obtain a high level of dimensional accuracy for the blade holder.

Response to Arguments

8. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Osenbruggen is not for use as a cutting mechanism. However, the claims call for cutting blade assembly and Osenbruggen teaches cutting tool (see Abstract). Also, applicant argues that Osenbruggen does not describe "an invention in which the cutting blade has a cutting face that does not have an opposite edge that is not positioned such that it can be compressed against another surface to improve the cutting characteristic of the blade" and "the position of the blade and its angle relative to the cutting blade holder or product being cut is determined by the angle at which the slot is made in the cutting blade holder". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that molding process is an inexpensive method of making the blade body, the fact that applicant has recognized another advantage which would

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flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Also, in response to applicant's argument that the modification Kubis to include angled slots in light of the teaching of Osenbruggen is erroneous because no rejection was made to combine Kubis with Osenbruggen as mentioned above. Kubis was only combined with Osenbruggen to provide an obvious use of the molding process.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Holmes et al. and Ma et al. are cited to show related device.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Flores-Sánchez whose telephone number is 703-308-0167. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ofs
September 4, 2004



KENNETH E. PETERSON
PRIMARY EXAMINER